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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
WONG, ERIC TAK WAI	
ART UNIT	**PAPER NUMBER**
3693	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/698,140	PETERSON ET AL.	
	Examiner	Art Unit	
	ERIC T. WONG	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *29 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 10-12, filed 2/29/2008, with respect to the rejection(s) of claim(s) 1-8, 10-14-16-18 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Election/Restrictions

2. Newly submitted claim 26 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any method of recommending the sale of securities could be used with the financial advisory computer system. The subcombination has separate utility in other combinations because any financial advisor could use the method for recommending the sale of securities.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

3. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Ray et al. (US Patent 6,018,722).

4. Regarding claim 1,

Ray et al. teaches receiving a risk tolerance for a client; receiving preferences for the client (see column 4 line 66 - column 5 line 4); identifying assets held in the client's portfolio; based on the preferences and the risk tolerance for the client determining a recommended asset allocation (see abstract); providing a database with ratings for different financial assets (see column 6 lines 13-37); identifying an asset in a client's portfolio which is recommended to be sold (see FIG. 1); generating a list of alternative assets in a client's portfolio to be sold (see column 7, lines 38-47); wherein an asset is recommended to be sold based on one of the following criteria: (1) the asset is recommended to be sold to achieve a recommended asset allocation (2) the asset is recommended to be sold based on a specific client preference (3) the asset is recommended to be sold in order to achieve sector diversification (4) the asset is recommended to be sold based on a poor rating for the asset in the database (5) the asset is

recommended to be sold in order to reduce concentration in the asset (6) the asset is recommended to be sold to realize tax loss harvesting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Nikolov ("Selected Issues"), further in view of Reese (US Patent 6,236,980).

6. Regarding claim 2,

Ray et al. teaches identifying a plurality of assets in the client's portfolio which are recommended to be sold;

Ray et al. does not explicitly teach generating a plurality of tables wherein each asset of the plurality of assets which are recommended to be sold is included in one of the tables.

Nikolov teaches tables containing one or more rows, and a plurality of columns, each row corresponding to a specific asset (see page 33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the identifying a plurality of assets in the client's portfolio of Ray et al. with generating a plurality of tables wherein each asset of the plurality of assets which are recommended to be sold is included in one of the tables. One skilled in the art would have been

motivated to make the modification because it is useful to show a graphical representation of a list of assets.

Ray et al. and Nikolov do not explicitly teach each table corresponding to a reason which identifies the basis for recommending that assets contained in the table be sold.

Reese teaches identifying, in a table, the basis for recommending the sale or purchase of an asset (see FIGS. 4-6).

Therefore, it would have been obvious to modify the displaying in a table of assets which are recommended to be sold of Ray et al. in view of Nikolov further with identifying the basis for recommending the sale or purchase of each asset. One skilled in the art would have been motivated to make the modification for the benefit of increased transparency.

Reese does not explicitly teach each table corresponding to a reason. However, modifying the layout of information such that each table corresponds to a reason constitutes a mere rearrangement of data which does not patentably distinguish the claimed invention from the prior art since the modification would merely be taking attributes that are shared between rows of data in a table and regrouping the data based on that attribute.

6. Regarding claim 3,

Ray et al. teaches identifying a plurality of assets in the client's portfolio which are recommended to be sold;

Ray et al. does not explicitly teach generating a plurality of tables wherein each asset of the plurality of assets which are recommended to be sold is included in one of the tables.

Nikolov teaches tables containing one or more rows, and a plurality of columns, each row corresponding to a specific asset (see page 33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the identifying a plurality of assets in the client's portfolio of Ray et al. with generating a plurality of tables wherein each asset of the plurality of assets which are recommended to be sold is included in one of the tables. One skilled in the art would have been motivated to make the modification because it is useful to show a graphical representation of a list of assets.

Ray et al. teaches a ratings database but does not explicitly teach showing the rating as a column in a table.

Nikolov teaches including a column in a table showing a rating which corresponds to the asset which corresponds to the row (see page 33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the displaying in a table of assets which are recommended to be sold of Ray et al. in view of Nikolov further with including a column in a table showing a rating which corresponds to the asset which corresponds to the row. One skilled in the art would have been motivated to make the modification because it is useful to provide ratings for investment guidance.

Ray et al. and Nikolov do not explicitly teach each table corresponding to a reason which identifies the basis for recommending that assets contained in the table be sold.

Reese teaches identifying the basis for recommending the sale or purchase of an asset in a table (see FIGS. 4-6).

Therefore, it would have been obvious to modify the displaying in a table of assets which are recommended to be sold of Ray et al. in view of Nikolov further with identifying the basis for recommending the sale or purchase of each asset. One skilled in the art would have been motivated to make the modification for the benefit of increased transparency.

Reese does not explicitly teach each table corresponding to a reason. However, modifying the layout of information such that each table corresponds to a reason constitutes a mere rearrangement of data which does not patentably distinguish the claimed invention from the prior art. The modification would merely be taking attributes that are shared between rows of data in a table and regrouping the data based on that attribute.

7. Regarding claim 4,

Ray et al. teaches wherein the preferences for the client includes an identification of specific assets that a client wants to sell (see column 5 lines 9-12).

8. Regarding claim 5,

Ray et al. and teaches wherein the client preferences for the client includes an identification of specific assets that a client wants to hold (see column 5 lines 9-12).

9. Claims 6, 9-11, 14, 16, and 23-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Masand et al. (US PG-Pub No. 2002/0095361 A1).

10. Regarding claim 6,

Ray et al. teaches receiving a client's risk tolerance and preferences; identifying assets held in the client's portfolio; based on the client preferences and the client risk tolerance

determining a recommended asset allocation; providing a database with ratings for different financial assets; identifying a first set of assets held in the client's portfolio which are recommended to be sold, identifying a second set of assets recommended to be purchased and included in the client's portfolio, wherein the identification of the first set of assets takes into account the ratings for assets provided in the database; wherein the identification of the second set of assets takes into account the ratings for assets provided in the database; and wherein if a client sells the first set of assets, and purchases the second set of assets, an asset allocation for the client's portfolio will be closer to the recommended asset allocation, than if the client does not make purchases o' sales in the client's portfolio.

Ray et al. does not explicitly teach for at least one asset of the first set of assets to be sold generating a group of alternative assets which could be sold; and for at least one asset in the second set of assets providing a group of alternative recommended assets to purchase.

Masand et al. teaches displaying a list of securities similar to a given security (see paragraph 16).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the recommending the purchase or sale of an asset of Ray et al. with generating groups of alternative assets which could be sold or purchased. One skilled in the art would have been motivated to make the modification in order to cater to user preference.

11. Regarding claim 9,

Ray et al. teaches recommending the sale of a set of assets based on the following criteria (1) an asset is recommended to be sold to bring the client portfolio closer to the recommended asset allocation (2) an asset is recommended to be sold based on a specific

client preference (3) an asset is recommended to be sold in order to achieve sector diversification (4) an asset is recommended to be sold based on a poor rating for the asset in the database (5) an asset is recommended to be sold in order to reduce concentration in the asset (6) an asset is recommended to be sold to realize tax loss harvesting.

12. Regarding claim 10,

Ray et al. teaches identifying assets held in a client's portfolio includes identifying multiple accounts owned by the client, and identifying all of the assets held in each of the multiple accounts (see column 9 lines 14-22).

13. Regarding claim 11,

Ray et al. teaches wherein the client preferences include an identification of specific assets held in the client's portfolio that the client does not want to sell (see column 5 lines 9-12).

14. Regarding claim 14,

Ray et al. teaches identifying assets held in a client portfolio; inputting a client's preferences and risk tolerance; determining a recommended asset allocation based on the client preferences and risk tolerance; identifying first set of assets in the client portfolio which are recommended to be sold; identifying a second set of assets which are recommended to be purchased and held in the client portfolio; providing a database with ratings for different assets; providing a microprocessor which is operable to apply a set of rules which are used to identify the first set of assets, and the second set of assets, wherein the rules include recommending the selling of an asset which is identified as having a low rating in the database;

Ray et al. does not explicitly teach for an asset which is included in the first set of assets identifying an alternative set of assets which could be sold.

Masand et al. teaches displaying a list of securities similar to a given security (see paragraph 16).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the recommending the sale of an asset of Ray et al. with identifying an alternative set of assets which could be sold. One skilled in the art would have been motivated to make the modification in order to cater to user preference.

15. Regarding claim 16,

Ray et al. does teaches identifying a reason for recommending the purchase of an asset. Reese also teaches identifying a reason for recommending the purchase of an asset (see FIGS. 4-6).

16. Regarding claim 23,

Ray et al. teaches wherein the reason for recommending the purchase of the asset is related to the client preferences and risk tolerance.

17. Regarding claim 24,

Ray et al. teaches wherein the reason for recommending the purchase of the asset is related to the rating of the asset in the database (see column 6 lines 13-37).

18. Regarding claim 25,

Ray et al. teaches wherein the reason for recommending the purchase of the asset is independent of another client portfolio.

19. Claims 7-8, 12-13, and 17-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Masand et al., further in view of Nikolov, further in view of Reese.

20. Regarding claims 7 and 8,

See discussion of claim 2.

21. Regarding claims 12 and 13,

See discussion of claim 3.

22. Regarding claims 17 and 18,

See discussion of claim 3.

23. Claims 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view Nikolov, further in view of Masand et al.

24. Regarding claims 19 and 20,

Nikolov teaches generating a table wherein each asset of a set of assets are included in the table, and wherein the table contains one or more rows, and a plurality of columns, and each row corresponds to a specific asset.

Nikolov does not teach providing an edit field where a user can select the edit field; And in response to a user selecting and edit field in a row corresponding to an asset, displaying a group of recommended alternative assets which could be sold or purchased.

Masand et al. teaches displaying a list of securities similar to a given security (see paragraph 16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the table of Nikolov with displaying a list of similar securities which could be sold or purchased. One skilled in the art would have been motivated to make the modification for the benefit of catering to user preference.

Masand et al. does not explicitly teach an edit field. However, Examiner asserts that edit fields, such as a drop-down box, were old and well known in the art at the time of invention.

It would have been obvious to one of ordinary skill in the art to modify the table of Nikolov further with using an edit field in order to display the list of alternative securities. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

25. Claims 15 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Masand et al., further in view of Sloan et al. (US PG-Pub 2002/0147671).

26. Regarding claim 15,

Ray et al. teaches recommending the sale of holdings in a security in order to achieve a predetermined asset allocation where an asset has a rating in the database which indicates poor future expected performance.

Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the recommending the sale of holdings in a security of Ray et al. with recommending such that the security will represent no more than 20% of the client's portfolio. One skilled in the art would have been motivated to make the modification for the benefit of achieving diversification.

Ray et al. does not explicitly teach where a first group of securities are of a first sector type, and where the first group of securities are more than 20% above a recommended benchmark sector weight for the first sector type, recommending the sale of some of the securities in the first group to bring an exposure to the first sector type down to 10% above the recommended benchmark sector weight for the first security type.

Sloan et al. teaches recommending the sale of securities within a sector to bring an exposure to sector down.

Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the recommending the sale of securities of Ray et al. with where a first group of securities are of a first sector type, and where the first group of securities are more than 20% above a recommended benchmark sector weight for the first sector type, recommending the sale of some of the securities in the first group to bring an exposure to the first sector type down to 10% above the recommended benchmark sector

weight for the first security type. One skilled in the art would have been motivated to make the modification for the benefit of achieving diversification.

27. Regarding claim 21,

Ray et al. teaches recommending the selling of a first asset which represents an over concentration of the portfolio in the first asset;

Ray et al. does not explicitly teach recommending the selling of a second asset where the second asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector.

Sloan et al. teaches recommending the selling of a second asset where the second asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector (see FIG. 5 element 240).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the recommending the sale of an asset of Ray et al. with recommending the sale of an asset where the asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector. One skilled in the art would have been motivated to make the modification to reduce risk through diversification.

28. Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Masand et al., further in view of Sloan et al., further in view of Karp et al. (US Patent 6,832,209 B1).

29. Regarding claim 22,

Ray et al. does not explicitly teach recommending the selling of a third asset in order to realize a capital loss.

Karp et al. teaches recommending the selling of an asset in order to realize a capital loss (see column 4 lines 18-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the recommending a sale of an asset of Ray et al. with recommending the sale in order to realize a capital loss. One skilled in the art would have been motivated to make the modification for the benefit of reducing taxable income.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

April 21, 2008